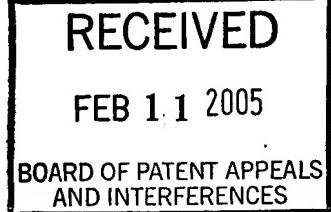


Patent
Attorney Docket No. ITW7510.005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Deonarine, Victor I.
Serial No. : 09/682,780
Filed : October 18, 2001
For : **METHOD AND APPARATUS TO EXTEND AND
RETRACT A TEMPERATURE INDICATOR STICK**
Group Art No. : 3679
Examiner : Cottingham, J.



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CERTIFICATION UNDER 37 CFR 1.8(n) and 1.10

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RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
MAILED JANUARY 11, 2005

Dear Sir:

Responsive to the Notification of Non-Compliant Appeal Brief mailed January 11, 2005, please enter the Appeal Brief presented herewith and consider the following remarks.

Deonarine, Victor I.

U.S. Serial No. 09/682,780

REMARKS

Responsive to the Appeal Brief filed October 13, 2004, the Office has provided a Notice of Non-Compliant Appeal Brief (hereinafter the Notice) alleging several deficiencies in the Appeal Brief filed October 13, 2004. Appellant has filed a corrected Appeal Brief under separate cover herewith.

The Notice first indicates, at Note 1, that the Brief does not contain the items required under 37 C.F.R. §41.37(c), or that items are not under the proper heading or in the proper order. Title 37 C.F.R. §41.37(c) requires an appeal brief to "include the following items under appropriate headings and in the order indicated in the paragraphs". Apparently the Office's interpretation of this section dictates that the only "appropriate" heading is the heading title of each of the respective sections. Although Appellant believes that the headings provided were "appropriate" for the subject matter contained thereunder, to expedite passage of this matter from the Examiner to the Board of Appeals, Appellant has revised the headings of the sections of the Appeal Brief to quote, verbatim, the headings of 37 C.F.R. §41.37(c)(1)(i)-(viii).

The Office next rejected the Appeal Brief at Note 4 of the Notice as failing to contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal with reference to the specification by page and line number and to the reference numbers, if any, or the drawings. Appellant has revised the Appeal Brief to incorporate extensive reference to the drawings. Appellant has not revised the Appeal Brief to refer to page and line numbers of the Specification. As originally filed, the Appeal Brief included reference to the Specification by paragraph numbers for that which is discussed. The Application which has resulted in this Appeal was filed electronically using the Office's electronic authorizing and submission software, PASAT and E-PAVE. The Office's software automatically numbered the paragraphs of the application, and did not provide page and line numbering. Accordingly, attempting to cite to the Specification by anything other than paragraph numbers would invariably result in confusion between Appellant and the Board as Appellant only has a version of that which was filed that includes paragraph numbers. Appellant has incorporated line numbers in the Appeal Brief only after appropriate paragraph citations to expedite the Board's review and analysis of that which is cited therein.

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Note 4 further rejects the Appeal Brief as failing to identify each independent claim, and dependent claim argued separately, subject to 35 U.S.C. §112, sixth paragraph interpretation and failure to set forth the structure, material, or acts corresponding to the claimed function with reference to the Specification and drawings. Appellant has revised Section Five (5) of the Appeal Brief to identify the claimed subject matter entitled to 35 U.S.C. §112, sixth paragraph interpretation with supporting citations to the Specification.

The Notice, in Note 5, further rejects the Appeal Brief for failing to contain a concise statement of each ground of rejection presented for review as required under 37 C.F.R. §41.37(c)(1)(vi). Appellant respectfully disagrees. Note 6 of the Appeal Brief states, in part, "The Examiner has rejected claims 1-26 as anticipated under 35 U.S.C. §102(b) by Fox (USP 4,875,782) hereinafter Fox." As stated on page 49962 of Vol. 69, No. 155 of the Federal Register, "[i]n paragraph (c)(1)(vi), a concise statement listing each ground of rejection presented for review is required rather than the issues for review" and that "[a]n example of a concise statement is 'Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X.'" Federal Register, Vol. 69, No. 155, pg. 49962, (August 2004). Appellant's statement is clearly a "concise statement listing each grounds of rejection" as the Examiner presented only one grounds of rejection of all of the pending claims in the May 26, 2004 Office Action. The Examiner rejected all claims as being anticipated by Fox. Accordingly, Appellant's statement is both concise and lists each ground of rejection for review. As such, the originally filed Appeal Brief is in compliance with 37 C.F.R. §41.37(c)(1)(vi).

The Office further rejected the Appeal Brief as failing to present an argument under a separate heading for each ground of rejection on appeal. Appellant is unclear what the Office is objecting to in the format of the Appeal Brief. Heading 7 of the originally filed Appeal Brief was titled "Rejection Under 35 U.S.C. §102(b) By Fox" -- the only rejection of the Final Office Action. If the Office is objecting the lack of the term "ARGUMENT" at Heading 7, Appellant has inserted the term at Heading 7. Thereunder, Appellant has provided argument for the collective patentability of claims 1-26 over the art of record as well as arguments directed to each claim individually. That is, each claim is addressed collectively under the heading "CLAIMS 1-26" and individual claims are argued and identified under headings and subheadings indicating the respective claim addressed individually thereunder.

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It is Appellant's position that the Office has disregarded long-standing and binding legal precedents and principles in rejecting each of the claims under 35 U.S.C. §102(b). As such, arguments that apply to each of the claims argued, rather than being reproduced under each individual claim heading, have been presented under the heading "CLAIMS 1-26". Those arguments directed to the patentability of individual claims over the art of record have been clearly segregated by claim numbers wherein the headings "CLAIM #" and sub-headings "Claim #" separate the arguments related to specific claims and further differentiate independent from dependent claims. Again, as provided in the Federal Register, "As another example, where claims 1 to 3 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. Z and the appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Z*, and the optional subheadings would be *Claim 1*, *Claim 2*, and *Claim 3*." Federal Register, Vol. 69, No. 155, pg. 49963, (August 2004). Appellant has clearly complied with the guidelines provided in the Federal Register. Additionally, as the heading and subheading example is stated as a "possible" heading configuration, there must clearly be other acceptable heading/subheading configurations. Nonetheless, as Appellant has provided headings and subheadings that comport with the examples as provided in the Federal Register, Appellant's Appeal Brief, contrary to the ambiguous rejection thereto in Note 6 of the Notice, is in compliance with 37 C.F.R. §41.37(c)(1)(vii).

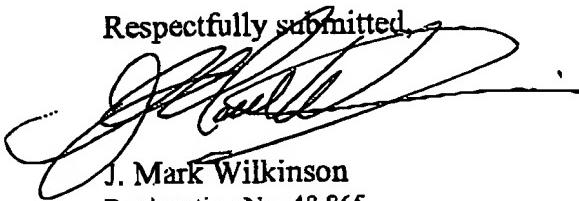
The Notice next rejected the Appeal Brief as failing to include an Evidence appendix and failing to set forth where in the record that evidence was entered by the Examiner. Appellant has revised the Appeal Brief to cite directly to the dictionaries cited therein and has removed the courtesy copy of those definitions to which the Office objects. Additionally, Appellant has referenced in the citations thereto, where applicable, where the documents appear in the record.

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Accordingly, Appellant believes that the Appeal Brief filed concurrently herewith is in compliance with the requirements of 37 C.F.R. §41.37. To expedite continued prosecution of the above captioned application, Appellant cordially requests the Office telephone the undersigned should any matter be considered unresolved which would result in non-entry of the Appeal Brief included herewith.

Respectfully submitted,



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Dated: February 11, 2005
Attorney Docket No.: ITW7510.005

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